

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 22

UNITED STATES PATENT AND TRADEMARK OFFICE

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U.S. PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte FRANKLIN M. BAEZ

Appeal No. 2003-0834
Application 09/148,392

ON BRIEF

Before KRASS, HAIRSTON, and SAADAT, Administrative Patent Judges.
SAADAT, Administrative Patent Judge.

REMAND TO THE EXAMINER

This is an appeal from the final rejection of claims 1-20 and 22-29. Claim 21 has been canceled.

This remand to the examiner pursuant to 37 CFR § 41.50(a)(1) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)) is made for further consideration of the rejections and appropriate action with respect to the matters discussed below. Accordingly,

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37 CFR § 41.50(a)(2) applies if a supplemental examiner's answer is written in response to this remand by the Board.

According to the Examiner (answer, page 5), claims 1-20 and 22-29 are rejected under 35 U.S.C. § 102(e) as being anticipated by Jyu. The Examiner refers to a prior Office action (Paper No. 12) for the discussion of the rejection and points out that the remaining rejections based on other prior art references also stand (answer, page 5). However, the Examiner states that the analysis related only to the rejection based on the above noted prior art is provided (id.). In response to Appellant's arguments addressing each of the multiple rejections based on different cited references, the Examiner refers this panel to every Office action in this application (Papers No. 2, ~~4~~, ~~8~~, 12 and ~~14~~) for the discussion of the rejections based on the references other than Jyu (answer, page 6).

Our consideration of the record leads us to conclude that this case is not in condition for a decision on appeal. Accordingly, we remand the application to the Examiner for identifying one single Office action ^{#12} that includes the statement of the rejections applied to the appealed claims. Instead of referring to multiple papers, the Examiner is directed to choose

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one single prior Office action as required by the provisions of MPEP § 1208.

The Examiner is also reminded that, based on the nature of multiple rejections applied to the same claims, the references appear to be cumulative. If the Examiner finds that all of the prior art references are necessary, the Examiner is required to provide relevant arguments in the answer for each and every rejection. Otherwise, the Examiner should select the best prior art reference for rejecting the claims by removing the cumulative evidence so that the arguments in the answer may be properly limited to the rejection of the claims based on that reference. *7394 only*


It is the Examiner and not this panel who has the burden of providing detailed fact finding with respect to the applied prior art and relevant analysis of the rejections based on such prior art in support of unpatentability of the claimed subject matter.

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This application, by virtue of its "special" status, requires an immediate action. See Manual of Patent Examining Procedure (MPEP) § 708.01 and 1211 (8th Ed., Rev. 2, May 2004). It is important that the board be informed promptly of any action affecting the appeal in this case.

REMANDED


KENNETH W. HAIRSTON
Administrative Patent Judge)


ERROL A. KRASS
Administrative Patent Judge)


MAHSHID D. SAADAT
Administrative Patent Judge)

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